

ESTTA Tracking number: **ESTTA718599**Filing date: **01/06/2016**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Proceeding	91224626
Party	Defendant Gatto Astucci S.p.A.
Correspondence Address	JONATHAN MYERS LUCAS & MERCANTI LLP 30 BROAD STREET, 21ST FLOOR NEW YORK, NY 10004 UNITED STATES JMmail@lmiplaw.com, jmyers@lmiplaw.com
Submission	Answer and Counterclaim
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Signature	/jonathan myers/
Date	01/06/2016
Attachments	RAIM-1014 Opp Answer & Counterclaim.pdf(331230 bytes) Attachment 1.pdf(804022 bytes) Attachment 2.pdf(397116 bytes) Annex A.pdf(100221 bytes) Annex B - FROM ENCICLOPEDIA TRECCANI.pdf(33320 bytes) Annex C - Giorgio fedon & figli leaflet.pdf(720282 bytes) Annex D - Google search for Astucci (1).pdf(3345837 bytes) Annex D - Google search for Astucci (2).pdf(2259678 bytes)

Registration Subject to the filing

Registration No	2627183	Registration date	10/01/2002
Registrant	Astucci U.S. Ltd. 385 Fifth Avenue New York, NY 10016 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 009. First Use: 1994/06/10 First Use In Commerce: 1994/08/01 All goods and services in the class are requested, namely: EYEGLASS CASES
Class 018. First Use: 1994/06/10 First Use In Commerce: 1994/08/01 All goods and services in the class are requested, namely: HANDBAGS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 79/154,399

Filed: 24 June 2014

Mark: GATTO ASTUCCI 1937 & Design

Published for Opposition: 30 June 2015

ASTUCCI U.S. LTD.,

Opposer,

v.

Opp. 91224626

GATTO ASTUCCI S.P.A.,

Applicant.

**ANSWER TO NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES AND
COUNTERCLAIM FOR CANCELLATION**

Pursuant to TBMP Sections 310, 311 and 313, Applicant Gatto Astucci S.p.A. acting by and through its undersigned counsel, hereby responds to Opposer Astucci U.S. Ltd.'s Notice of Opposition as follows:

To the extent that Applicant's introductory paragraph states factual allegations, Applicant is without knowledge or information

sufficient to form a belief as to the truth of the allegations related to Astucci U.S. Ltd.'s business address, and, therefore denies the same. Applicant denies that Astucci U.S. Ltd. will be damaged by the registration of the mark GATTO ASTUCCI 1937 & Design as identified in US Trademark Application Serial No. 79/154,399. Applicant admits that US Trademark Application Serial No. 79/154,399 speaks for itself. Applicant denies that Astucci U.S. Ltd. is entitled to any relief under the Lanham Act Section 2(d).

1. Applicant admits the allegations contained in paragraph 1 of the Notice of Opposition.
2. Applicant admits all of the allegations contained in paragraph 2 of the Notice of Opposition except the statement that U.S. Trademark Application Serial No. 79/154,399 was filed based purportedly on intent-to-use, which Applicant denies. Applicant has used its mark GATTO ASTUCCI 1937 & Design in commerce which the U.S. Congress can regulate, continuously and without interruption since at least as early as 1991.
3. Applicant admits the allegations contained in paragraph 3 of the Notice of Opposition.
4. Applicant admits the allegation contained in paragraph 4 of the Notice of Opposition.
5. Applicant admits the allegation contained in paragraph 5 of the Notice of Opposition.
6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 6 of the Notice of Opposition and therefore denies the same.

7. Applicant admits that Opposer is the owner of U.S. Trademark Registration 2,627,183 for the mark ASTUCCI which was registered on 1 October 2002. Applicant denies that the registration is wholly incontestable pursuant to 15 USC 1065, because paragraph 4 of the statute states that "no incontestable right shall be acquired in a mark which is the generic name for the goods and services or a portion thereof, for which it is registered."
8. Applicant admits the allegations contained in paragraph 8 of the Notice of Opposition.
9. Applicant denies the allegations contained in paragraph 9 of the Notice of Opposition.
10. Applicant denies the allegations contained in paragraph 10 of the Notice of Opposition.
11. Applicant denies the allegations contained in paragraph 11 of the Notice of Opposition.
12. Applicant admits that its goods and Opposer's goods both include eyeglass cases and products related to eyeglass cases including the sale and marketing of eyeglass cases. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 12 of the Notice of Opposition and therefore denies the same.
13. Applicant denies the allegations contained in paragraph 13 of the Notice of Opposition.
14. Applicant denies the allegations contained in paragraph 14 of the Notice of Opposition.
15. Applicant denies the allegation contained in paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations contained in paragraph 16 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

Astucci U.S. Ltd.'s claims alleged in the Notice of Opposition fail to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

Astucci U.S. Ltd. will not suffer any damage by Applicant's registration and use of the mark GATTO ASTUCCI 1937 & Design as identified in U.S. Trademark Application Serial No. 79/154,399.

THIRD AFFIRMATIVE DEFENSE

Applicant applied for its mark GATTO ASTUCCI 1937 & Design in good faith.

FOURTH AFFIRMATIVE DEFENSE

Astucci's claims are barred by laches, acquiescence, waiver and/or estoppel.

FIFTH AFFIRMATIVE DEFENSE

Applicant's mark GATTO ASTUCCI 1937 & Design and Opposer's mark ASTUCCI give very different overall commercial impressions such that there is no likelihood of confusion in the U.S. marketplace between goods bearing the respective marks.

SIXTH AFFIRMATIVE DEFENSE

Opposer's Mark ASTUCCI means "cases" in everyday Italian and, in particular in Italian, eyeglass cases are often referred to as "astucci." Italian is a language spoken and understood by many American consumers. Under the "doctrine of foreign equivalents" "astucci" is the equivalent common descriptive term (generic term) for "cases" and so U.S. Trademark Registration 2,627,183 is invalid on the grounds that "ASTUCCI" is generic for "cases". Since both eyeglass cases in Class 9 and handbags [pocketbooks, purses, small suitcases] are cases, U.S. Trademark Registration 2,627,183 is invalid under 15 USC 1064.

Applicant reserves the right to amend its Answer to the Amended Notice of Opposition, to amend its Affirmative Defenses, to assert such additional Affirmative Defenses as it deems appropriate and such Counterclaims as may be permitted that may now exist or in the future are available based on discovery and further factual investigation in the proceeding.

WHEREFORE, Applicant respectfully requests that the above-captioned Notice of Opposition be dismissed in its entirety, that United States Trademark Application Serial No. 79/154,399 for GATTO ASTUCCI 1937 & Design be allowed for registration, and that the Board grant Applicant such other and further relief as it deems just and appropriate.

COUNTERCLAIM

Applicant believes that it is and will continue to be damaged by Opposer's pleaded U.S. Registration 2,627,183 and hereby counterclaims for cancellation of said Registration.

As grounds for this counterclaim, Applicant alleges that the word "astucci" in Italian is the foreign equivalent of "cases" in English and that Registrant has no right to monopolize a common descriptive or generic term such as "cases" as a trademark for eyeglass cases, handbags or any other kind of case. Applicant further alleges that Italian is a modern language spoken and understood by many residents of the United States such that there are many individuals in the United States who know that "astucci" in Italian is the equivalent of "cases" in English.

In support of the counterclaim Applicant alleges the following:

1. Opposer's registration for the mark ASTUCCI is directed to eyeglass cases in Class 9 and handbags [pocketbooks, small suitcases] in Class 18 and that both eyeglass cases and handbags are "cases". See the definition of handbag as "suitcase, pocketbook" from the Merriam-Webster's Collegiate Dictionary, 10th Edition, pp 526, 897 (1998), Attachment 1 and the definition of "handbag" from the Funk & Wagnalls' Standard Desk Dictionary, p. 291 (1984), Attachment 2.

2. The word “astucci” in Italian is the foreign equivalent of “cases” in English as can be seen by reading Attachment A which includes dictionary definitions of “astucci” from the Cambridge Dictionary and from Oxford Paravia.
3. Further evidence is provided in Attachment B that the word “astucci” in Italian is the foreign equivalent of “cases” in English from the Italian Encyclopedia Treccani which includes an English translation.
4. There are third parties in Italy who sell a variety of cases including Giorgio Fedon & Figli, who refer to the cases as “astucci” in the common descriptive or generic sense and American consumers, who understand Italian and who are familiar with Italian products, would equate “astucci” with “cases”. See Attachment C.
5. In Italian eyeglass cases are often referred to as “astucci” as can be seen by reading Attachments D1 and D2, two internet searches for “astucci” which includes photographs of eyeglass cases, handbags and other cases all referred to in a common descriptive or generic sense as “astucci.”

WHEREFORE, Applicant/Cancellation Petitioner Gatto Astucci S.p.A. respectfully request that this Counterclaim/Petition to Cancel Opposer’s pleaded US Trademark Registration 2,627,183 be granted and that said registration relied upon by Opposer in this opposition proceeding be canceled.

This Counterclaim for Cancellation is submitted together with the statutory filing fee of \$600. Should any additional fee be required, please charge the same to our Account 022275 and notify the undersigned accordingly.

Respectfully submitted,

Lucas & Mercanti, LLP,



By Jonathan Myers

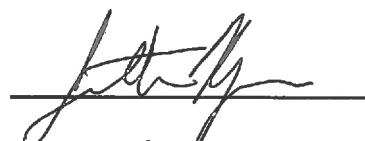
Attorney for Applicant

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the Answer to Notice of Opposition, Affirmative Defenses and Counterclaim has been served on the attorney of record for the Opposer via First Class Mail, this 6th day of January 2016 at the following address:

David B. Sunshine, Esq.
Cozen O'Connor, P.C.
277 Park Ave.
New York, New York 10172



Jonathan Myers

Merriam-
Webster's
Collegiate®
Dictionary



Attachment 1

TENTH EDITION

Merriam-Webster, Incorporated
Springfield, Massachusetts, U.S.A.



A GENUINE MERRIAM-WEBSTER

The name *Webster* alone is no guarantee of excellence. It is used by a number of publishers and may serve mainly to mislead an unwary buyer.

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1. English language—Dictionaries. I. Merriam-Webster, Inc.
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423—dc21

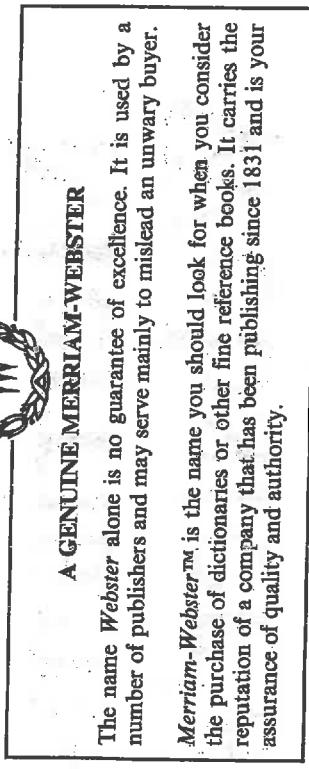
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Made in the United States of America

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Preface

Explanatory Cha-

Explanatory Not-

The English Language in the Dictionar-

Guide to Pronunciatio-

Abbreviations in This Wor-

Pronunciation Symbol

A Dictionary of the English Languag-

Abbreviations and Symbols for Chemical Element

Foreign Words and Phrases

Biographical Name;

Geographical Names

Signs and Symbols

A Handbook of Style

Index

Funk & Wagnalls Standard Desk Dictionary

VOLUME 1
A-M

Attachment 2

Funk & Wagnalls, Inc.
Publishers since 1876

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PREFACE

EDITORIAL STAFF

GUIDE TO THIS DICTIONARY

- Pronunciations by *James B. McMillan*
Level and Style Labels by *Frederic G. Cassidy*
Etymologies by *Albert H. Marckwardt*
Synonyms by *S. I. Hayakawa*

TABLES

- Weights and Measures
Table of English Spellings
Special Signs and Symbols
Pronunciation Key
Abbreviations Used in This Book

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"STANDARD" is a registered trademark of Harper & Row, Publishers, Inc.

DICTIONARY OF THE ENGLISH LANGUAGE

SUPPLEMENT

- Common Computer Terms
A Pronouncing Gazetteer
Biographies
Abbreviations and Acronyms

SECRETARIAL HANDBOOK by *Alice Ottum*

- Word Usage and Word Relationships
Punctuation
Capitalization
Spelling
Confusing Words
Consistency of Tense and Person of Verbs
Business Correspondence
Forms of Address
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pressed against the back of his neck.

hamper (hām'pər) *n.* A large, usu. covered basket, often used to store soiled laundry. [< OF *hamper* a cup case

Annex A

Cambridge Dictionary

<http://dictionary.cambridge.org/it/dizionario/inglese-italiano/case>

Traduzione di "case" nel dizionario Inglese-Italiano

case

noun UK /keɪs/ US /keɪs/



A2 a large bag with a handle that you use for carrying clothes when you are travelling
valigia

A2 a container for storing or protecting something
astuccio, cofanetto
a pencil case

Oxford Paravia

<http://tbd.pearsonitalia.it/lemma/2784>

The Bilingual English Dictionary concise

Parola da cercare

Collegamenti

Lemmarario completo
Istruzioni per la ricerca
Dizionario di apprendimento della lingua inglese
I dizionari Paravia
Dizionario Inglese Longman

Acquista

Il dizionario cartaceo
Il dizionario con CD-Rom

astuccio

[ə'stutʃjo, tʃi]

pl. -ci

[lemma precedente](#)

[lemma seguente](#)

sostantivo maschile

1. (*custodia*) case; ~ **per occhiali** spectacle case
2. (*portapenne*) pencil case, writing case.

FROM ENCICLOPEDIA TRECCANI

scatola s. f. [prob. metatesi del lat. mediev. castula, di origine germ.]. – 1. a. Involucro di forma varia (per lo più parallelepipedo, talora cilindrica), generalm. fatto di cartone, ma anche di legno, metallo, plastica, ecc., sempre munito di coperchio, usato per contenere e conservare oggetti svariati: una s. di latta, di vetro, di plastica; metti il libro in una s. e spediscilo per posta; la s. delle scarpe, delle camicie, dei fazzoletti; una s. di cellofan per fiori; s. per cappelli..

box.. – 1. a. Container of various shape (mostly parallelepiped , sometimes cylindric) usually in cardboard, but also wood, plastic, metal., always including a cover used to contain different items.

astuccio s. m. [dal provenz. estug, der. di estojar, estujar, che risalgono forse al lat. *studiare «conservare con cura»; cfr. fr. étui]. – 1. Specie di scatola di materiale vario, generalmente foderata o imbottita all'interno e sagomata secondo l'oggetto che vi si deve riporre: a. per gioielli, a. della collana, a. portapenne, a. degli occhiali; a. d'argento, di cuoio, di plastica. 2. In biologia, il rivestimento che diversi animali costruiscono in vari modi e che serve loro di abitazione e...

case [from provenzale estug, der. di estojar, estujar, that goes backto the latin «to store with care»; cfr. fr. étui]. – 1. Sort of box of different material, usually lined (encased) or stuffed inside and shaped according to the shape of the object to be inserted into; a. for jewelry, a. of the neck ring, a. for pencils, a. for spectacles

Giorgio Fedon & Figli

ASTUCCI

VALLESELLA CADORE (Italia)

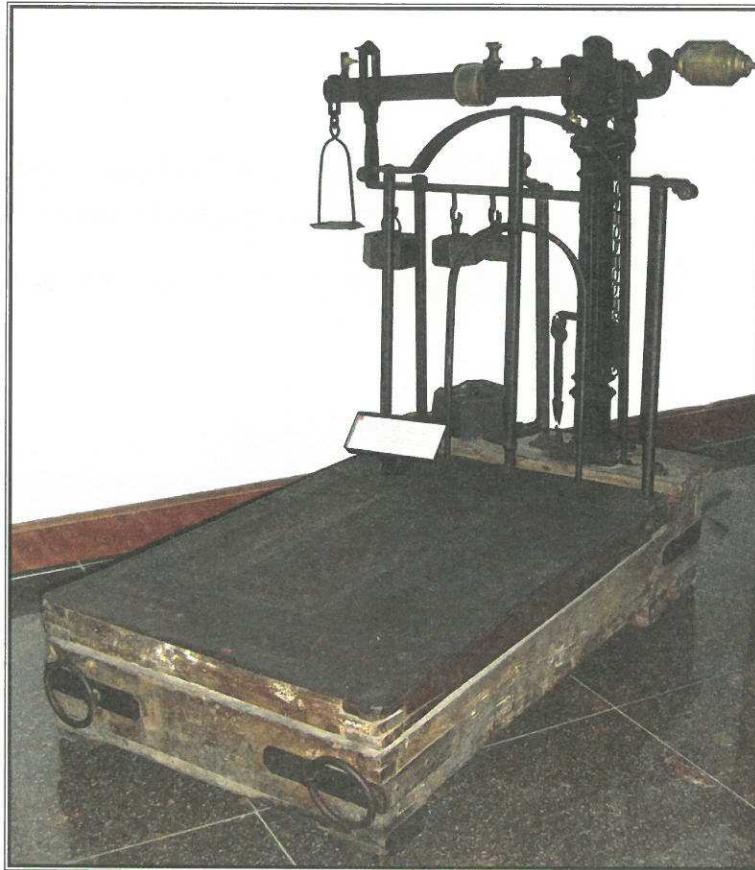
3.

STADERA
(inizio Novecento)

STEELYARD
(early XX century)

Bilancia usata per pesare i colli in spedizione.
La stadera è uno strumento di misura, di origine romana, basata sul principio delle leve.

Scale used to weigh packages.
Steelyard is a scale, of roman origins, based on the principle of the levers.



Un reparto di produzione nella prima fabbrica a Vallesella nell'intervallo tra le due guerre
Production department in the original factory in the period between world wars



La fabbrica nel secondo dopoguerra
The factory after the second world war



Giorgio Fedon & Figli

ASTUCCI

VALLESELLA CADORE (Italia)

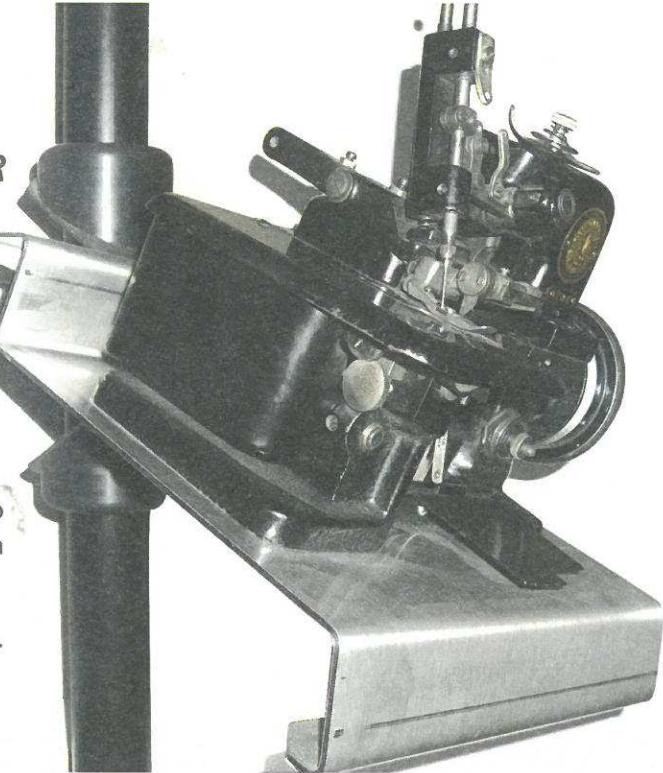
4.

MACCHINA DA CUCIRE SINGER
(metà Novecento)

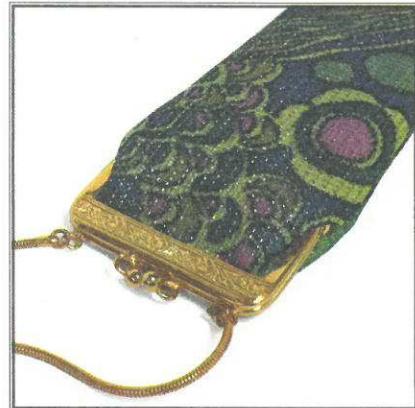
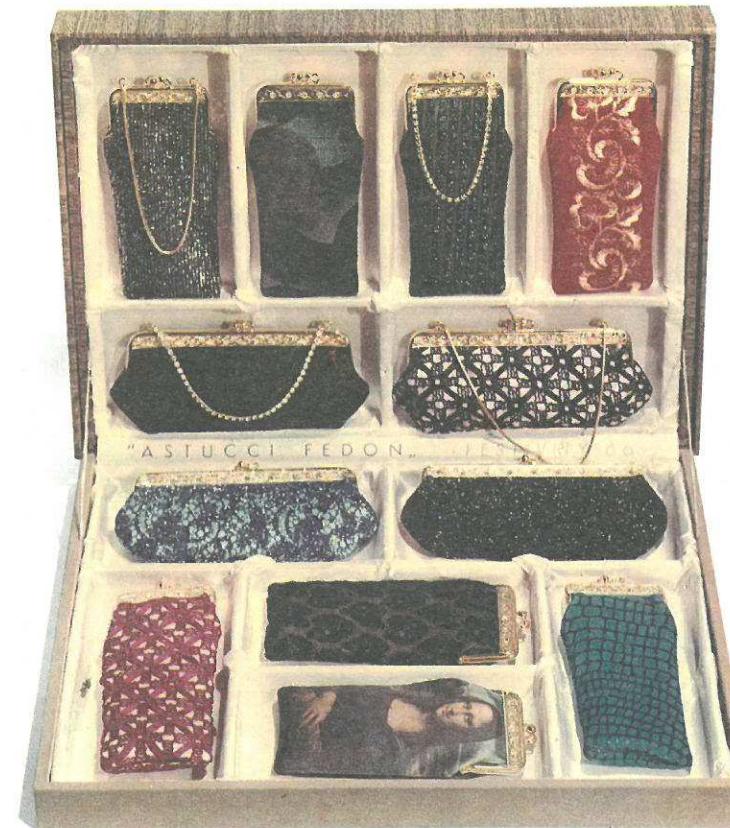
SINGER SEWING MACHINE
(mid XX century)

La bordatura degli astucci in tessuto prevedeva l'utilizzo di questa macchina da cucire.

Sewing machine used to edge fabric cases.



"Cartella Festivity" (anni '60)
"Festivity Cases" ('60s)





astucci

Accedi

Tutti Immagini Shopping Video Maps Altro ▾ Strumenti di ricerca

SafeSearch



Astucci Scolastici



Astucci Eastpak Fantasia



Astucci Legami

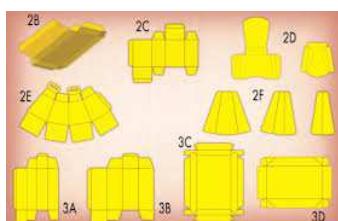


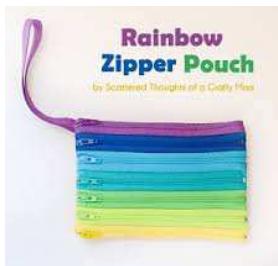
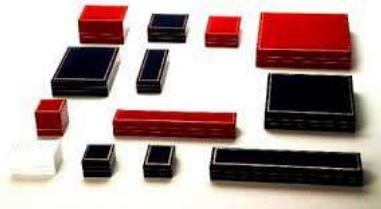
Astucci P





**PREZZO
SPECIALE**







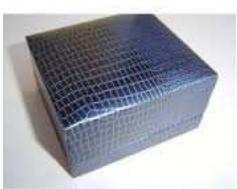


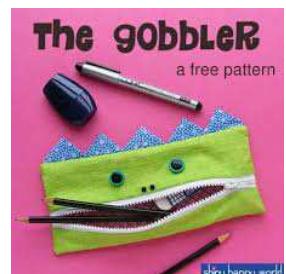






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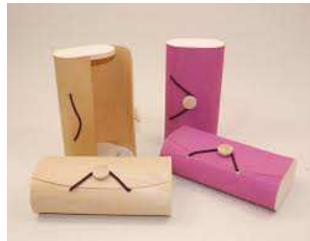
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Altri risultati



astucci per occhiali

Accedi

Tutti

Immagini

Shopping

Video

Notizie

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Strumenti di ricerca

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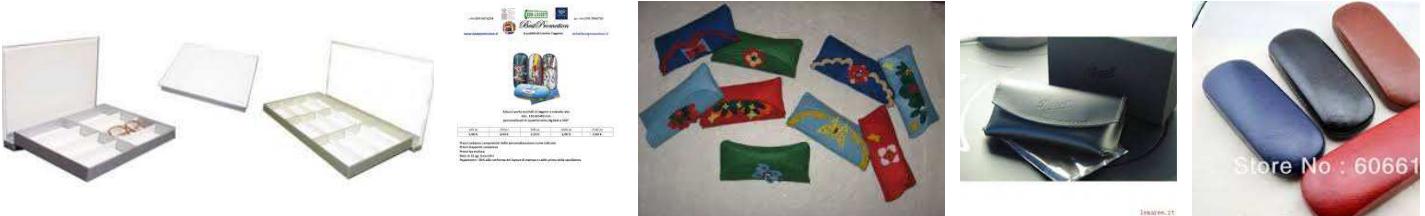
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pallini

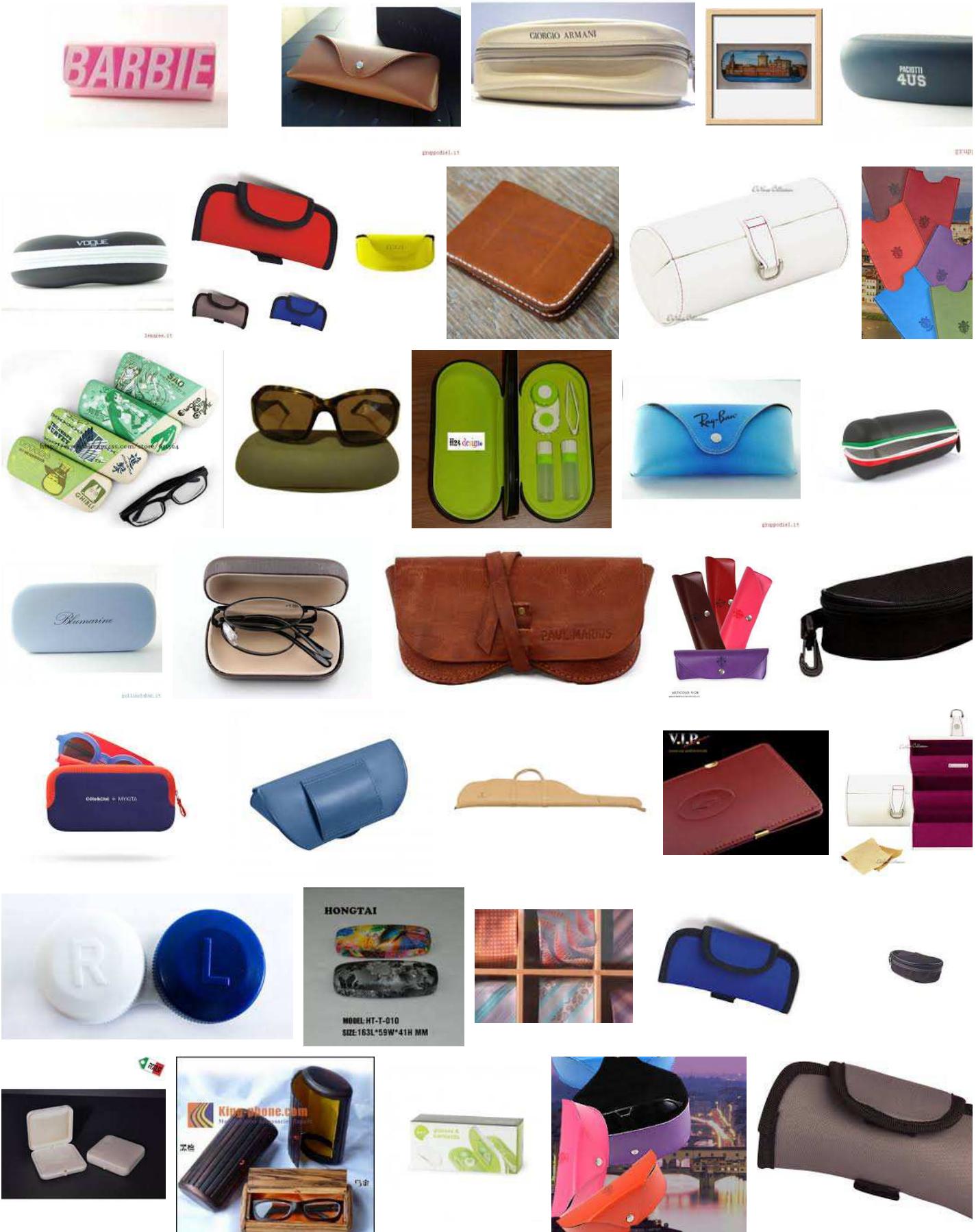


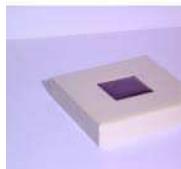
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**II MAIEROTTI
ASTUCCI**

astucci e accessori



Astuccio in legno scolpito
manifattura tedesca (?), 1839.

Astuccio per occhiali in legno
scolpito, di forma cilindrica.
Sull'esterno sono incisi dei motivi
floreali (corona d'ancanto), il nome
del proprietario, P. Holbij e
l'anno di fabbricazione.





Altri risultati